

Patent
Attorney Docket No. BASF.10156WOUS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Wolfgang von DEYN
Application No.: 10/581,109
Filing or 371(c) Date: May 31, 2006
Title: The Use of N-arylhydrazine
Derivatives for Combating Non-Crop
Pests

Mail Stop: Amendment
Group Art Unit: 4131
Examiner: Nannette Holloman
Confirmation No.: 5188

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In complete response to the Restriction Requirement mailed January 11, 2007, Applicants provisionally elect Group I, claims 15-17, 19-20 and 23-26, for prosecution in the present application. Applicants reserve the right to file divisional application(s) based on the non-elected claims. This election is made **with** traverse.

Applicants respectfully point out that the Restriction incorrectly states that Group III, claims 34-36, is drawn to a method of use of a bait composition. Rather, Group III, claims 34-36, is drawn to a bait composition, wherein the composition comprises a compound of formula I and an attractant.

This application is a National Phase Entry Under 35 U.S.C. § 371 and, as such, PCT Rule 13 requiring unity of invention applies. Title 37 of the Code of Federal Regulations states:

- (b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:
... (2) *A product and a process of use of said product.*

37 C.F.R. § 1.475 (b)(2) (Emphasis added).

Applicants respectfully submit that there is no lack of unity between Group III (product comprising compounds of formula I) and Groups I and II (use of compounds of formula I) because the product and process are related by the same compounds. As noted, 37 C.F.R. § 1.475 (b)(2) states that a national stage application has unity of invention between the product and process claims. Further, as discussed below, Applicants respectfully submit that additionally there is no lack of unity between Groups I and II.

The Restriction alleges that there is no special technical feature linking all the claims. The reasoning is as follows: The special technical feature linking the claims is a compound of formula I, and the reference by J.A. Furch *et al.* (“Furch”) teaches the use of *certain* amidrazone derivatives as insecticides against *crop pests*. Thus, it is alleged that present invention does not define a contribution over the art. Therefore, the feature linking the claims does not constitute a special technical feature under PCT Rule 13.2. Thus, there is no unity of invention. Restriction, p. 2.

Applicants respectfully point out that the Restriction does not address, at all, what would be the present invention’s contribution over the art, which is its relation to *non-crop pests*. This feature is recited in every claim. The Restriction states and indeed tacitly emphasizes the narrow teaching of Furch: “[certain amidrazones] target specifically *certain* coleopteran insects....” Id. (Emphasis added). Pests of the Coleopteran order are *crop pests*. See, e.g. Specification as filed, p. 4, lines 34-35. From this narrow teaching, the Restriction merely concludes that there is no contribution over the art, without even articulating that the invention’s contribution is related to *non-crop pests*.

The present specification as filed states that the activity of a compound against crop pests does not generally suggest activity of that compound against non-crop pests. See, Specification at p. 4, lines 23-25. This is because the requirements for activity against one is different from that of the other. Id. at lines 29-31. More striking, however, is the conclusion of the International Preliminary Report on Patentability (“IPRP”) of December 5, 2005, a copy of which was submitted along with this National Stage filing, which states that in Furch, “[t]he use of said compounds for combating non-crop pests is not mentioned. The subject matter of claims 1-14 is therefore new....” See, Re Item V, Reasoned Statement..., Separate sheet of the IPRP.¹ Consequently, there *must* be a contribution over the art. Moreover, as reported in the IPRP, the International Searching Authority found that all the original claims have unity of invention.

¹ In a Preliminary Amendment, original claims 1-14 were canceled, and the now-pending new claims were submitted. These new claims are of the same scope, and were merely rewritten in more conventional U.S. claim language.

In view of the above, Applicants respectfully submit that the Restriction between Groups I, II and III is improper. Therefore, Applicants respectfully request that each of these groups be examined together. Applicants believe all issues raised in the Restriction Requirement have been addressed. If any questions remain, the Examiner is invited to contact the undersigned at the number given below.

Although it is believed that no fee is necessary, the Director is hereby authorized to charge any appropriate fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-3218.

Respectfully submitted,

HUTCHISON LAW GROUP PLLC

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